

**REMARKS**

Claims 1-22 are pending in the Application.

Claims 1-22 stand rejected.

Claim 1 is canceled without prejudice or disclaimer.

**I. REJECTION UNDER 35 U.S.C. § 112, ¶ 2**

Examiner has rejected Claim 14-22 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Office Action, at 2. Claim 14 is amended herein to correct the antecedent basis problems identified by Examiner. *Id.* The Applicant respectfully asserts that the amendments to Claim 14 and incorporated by reference in any claims depending therefrom, are not narrowing amendments made for a reason related to the statutory requirements for a patent that will give rise to prosecution history estoppel. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 1839-40, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 234 F.3d 555, 566, 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2001).

The Applicant asserts that the rejection of Claims 14-22 under 35 U.S.C. § 112, ¶ 2, as being indefinite is traversed by the amendment to Claim 14.

**II. REJECTION UNDER 35 U.S.C. § 102**

Claims 1-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,665,565 to *Odom* (hereafter “*Odom*”). Office Action, at 2-3. Applicant traverses these rejections.

For a reference to anticipate a claimed invention, the reference must disclose every aspect of the claimed invention. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim.

*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

**Claim 1.** Claim 1 has been canceled without prejudice or disclaimer and its rejection has been rendered moot.

**Claim 2.** Claim 2 is an independent claim directed to a golf teaching aid comprising a first golf glove having a first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove and a second golf glove having a second attachment feature on a glove surface area above the palm surface of a second hand inserted into said second golf glove, wherein said first attachment feature couples to said second attachment feature when said second hand inserted in said second golf glove overlays said first hand inserted in said first golf glove while gripping a golf club. The Examiner states that *Odom* shows a first attachment feature as a portion of fastener 46 that is positioned on the thumb area on a glove surface area and cites Fig. 5 for support. Office Action, at 2-3. According to *Odom*, column 3, beginning at line 32, FIGS. 5 and 6 show a modified form of his invention wherein a golf club 40 includes a golf grip 42 having a loop fastener strip 44 attached around the entire part of its outer periphery. Likewise, *Odom* discloses that a cooperating fastener pile 46 is attached to the palm 48 of a golf glove 50 so that when golf club 40 is gripped by the golfer (using golf glove 48) the palm fastener 46 on golf glove 48 and the fastener pile 44 on golf grip 42 mesh thereby locking the golf glove 50 to golf grip 42. Relative to Fig. 5, *Odom* discloses how his modified golf glove 50 locks to a modified grip 42 on a golf club 40. Claim 2 is a golf teaching aid whereby features of first glove on one hand couple to features on a second glove on a golfer's other hand. Claim 2 does not recite coupling a glove to a modified grip as disclosed relative to Fig. 5 of *Odom*. Relative to Fig. 5, *Odom* does not show a first golf glove having a first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove. Fig. 5 only shows and *Odom* only discloses relative to Fig. 5 a single attachment feature on the palm surface of glove 50 that couples to a cooperating feature on the golf grip 42 of golf club 40. The Examiner states that with respect to the second attachment feature, column 1

lines 37-45 of *Odom* indicates that there are a pair of gloves that are mirror images. In column 1, lines 37-45, *Odom* states that each of his left and right golf gloves (of his present invention) are mirror images of each other. The first and second golf gloves of Claim 2 are not mirror images of each other. One of ordinary skill in the art will not arrive at the first and second golf gloves recited in Claim 2 using a left hand golf glove 50 of Fig. 5 and a corresponding “mirror image” right hand golf glove (not shown). Left hand golf glove 50 of Fig. 5 does not have the first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove and therefore a “mirror image” right hand golf glove corresponding to golf glove 50 also would not have the first attachment feature recited in Claim 2. Therefore, the Applicant respectfully asserts that the rejection of Claim 2 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 3.** Claim 3 is dependent from Claim 2 and contains all the limitations of Claim 2. Claim 3 adds the limitation that the first golf glove has a first location feature on a glove surface area above a palm surface of the first hand inserted into the first golf glove, the first location feature for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club. The Examiner states that *Odom* shows a first location feature on the first glove (46) above the palm surface. Office Action, at 3. The Examiner further states that Fig. 5 shows the area above the palm and the Examiner states that this area is considered a first location. *Id.* Claim 3 recites a first golf glove having a first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove and a second golf glove having a second attachment feature on a glove surface area above the palm surface of a second hand inserted into said second golf glove. In addition, the first golf glove has a first location feature on a glove surface area above a palm surface of the first hand inserted into the first golf glove, the first location feature for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club. Relative to Claim 2, the Examiner states that the first attachment feature is element 46 and relative to Claim 3, the Examiner states that the

first location feature is also element 46. Clearly, in the present invention, the first attachment feature is located on a glove surface area above the top of the thumb of the first hand inserted in the first golf glove and the first location feature is located above a palm surface of the first hand inserted into the first golf glove. The first attachment feature and the first location feature are two distinct elements in Claim 3. The Examiner has contradicted itself in stating the first attachment feature and the first location feature are element 46 of Fig. 5, wherein element 46 is an attachment feature used to couple to a cooperative feature 42 on golf club 40. See *Odom*, column 3, lines 32-44. Element 46 of *Odom* offers no help to a golfer in locating his hands on a golf club shaft. Element 46 of *Odom* broadly extends over nearly the entire palm surface of each of his glove 50 and his corresponding “mirror image” golf glove not shown. The cooperating element 42 on golf club 40 extends over the entire periphery of the grip and couples to element 46 but does not aid in locating the golfer's hand and thus is not a location feature. The Applicant asserts that nowhere in the disclosure does *Odom* disclose a first location feature as recited in Claim 3 of the present invention. Therefore, the Applicant respectfully asserts that the rejection of Claim 3 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 4.** Claim 4 is dependent from Claim 3 and contains all the limitations of Claim 3. Claim 4 adds the limitation that the first golf glove has a third attachment feature on a glove surface area above and adjacent to a top surface of an index finger of said first hand when inserted into said first golf glove. The Applicant has shown that *Odom* does not anticipate the invention of Claim 3. The invention of Claim 4 comprises a first golf glove with first and third attachment features and a first location feature and a second golf glove with a second attachment feature that couples to the first attachment feature. The Examiner states that “part of attachment element (46) located on the index finger is considered the third attachment feature.” Office Action, at 3. First, *Odom* discloses a single golf glove 50 that has a single attachment feature 46 that *Odom* states preferably extends along the palm side of the middle, ring, and little fingers. The first golf glove of Claim 4 has a first attachment feature on the top

side of the thumb of the first golf glove, a first location feature located above the palm surface of the first hand inserted into the first golf glove, and a third attachment feature on a glove surface area above and adjacent to a top surface of an index finger of said first hand when inserted into said first golf glove. The Examiner considers part of element 46 (which is entirely on the palm surface of the glove hand and finger areas) to be the third attachment feature recited in Claim 4. Office Action, at 3. Golf glove 50 shown in Fig. 5 of *Odom* has a single attachment feature (46) that *Odom* states preferably extends along the palm side of the middle, ring, little fingers, and the thumb. The third attachment feature is disposed on the glove surface area above and adjacent to a top surface of an index finger of the first hand not as part of element 46 which is on the palm side of the index finger as cited by the Examiner. Nowhere does *Odom* disclose a first attachment feature, a third attachment feature, and a first location feature on a first glove along with a second glove with a second attachment feature. Nowhere does *Odom* disclose any embodiment with a first location feature on a first glove for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club using the first glove. Therefore, the Applicant respectfully asserts that the rejection of Claim 4 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 5.** Claim 5 is dependent from Claim 4 and contains all the limitations of Claim 4. Claim 5 adds the limitation that the second golf glove has a fourth attachment feature on a glove surface area above and adjacent to a palm surface of a little finger of the second hand inserted into the second golf glove. The Applicant has shown that *Odom* does not anticipate the invention of Claim 4. The Examiner states that *Odom* discloses Claim 5 and states that the part of attachment element (46) located on the little finger is considered as the fourth attachment feature. Office Action, at 3. According to Claim 5, the fourth attachment is on the second glove along with the second attachment feature. Attachment feature 46 is located on golf glove 48 according to *Odom*, column 3, lines 32-44. Golf glove 48 does not have the first attachment feature and the first location feature recited. Attachment feature 46 is on a single golf glove 48. Likewise, a “mirror image” golf glove corresponding to

golf glove 48 does not have the first attachment feature and the first location feature. Therefore, the Applicant respectfully asserts that the rejection of Claim 5 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 6.** Claim 6 is dependent from Claim 5 and contains all the limitations of Claim 5. Claim 6 adds the limitation that the third attachment feature couples to and is retained by the fourth attachment feature when the little finger overlays the index finger as the second hand inserted in the second golf glove overlays the first hand inserted in the first golf glove while gripping a golf club. The Examiner states that the single attachment feature 46 on golf glove 48 is capable of performing the function recited in Claim 6. Office Action, at 3. The Applicant has shown that *Odom* only discloses a golf glove 48 with a single attachment feature 46 and a corresponding “mirror image” golf glove with the same attachment feature 46. The Applicant has shown that neither golf glove 48 nor the corresponding “mirror image” golf glove have the first attachment feature and the first location feature. Golf glove 48 and the corresponding “mirror image” golf glove only have attachment element 48 for coupling to loop fastener 44 on golf grip 42 of golf club 40. The third attachment feature of Claim 6 allows the golfer to use the first and second golf gloves with either the overlapping grip or the interlocking grips. With the overlapping grip, the fourth attachment feature on the palm side of the little finger overlays and couples to the portion of the third attachment feature on the top side of the index finger and with the interlocking grip the fourth attachment feature overlays and couples to the portion of the third attachment feature adjacent to (on the inside of) the top side of the index finger. The Applicant, therefore, asserts that *Odom* does not disclose the function of Claim 6 as it does not have the cooperative elements recited in Claim 6 and Claims 5, 4, and 2 from which it indirectly depends. Therefore, the Applicant respectfully asserts that the rejection of Claim 6 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 7.** Claim 7 is dependent from Claim 2 and contains all the limitations of Claim 2. Claim 7 adds the limitation that the first and second attachment features are mating elements selected from a group consisting of a hook and loop attachment

system, a magnetic attachment system, or a selective, separable adhesive based attachment system. The Examiner states that *Odom* discloses attachment features consisting of a hook and loop attachment system. Office Action, at 3. However, the Applicant has shown that *Odom* does not disclose a first golf glove with the first attachment feature and a second golf glove with the second attachment feature as recited by Claim 7. The Applicant is not claiming a simple hook and loop attachment system rather the Applicant is claiming the specific first and second golf gloves with first and second hook and loop attachment features. Therefore, the Applicant respectfully asserts that the rejection of Claim 7 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 8.** Claim 8 is dependent from Claim 5 and contains all the limitations of Claim 5. Claim 8 adds the limitation that the third and fourth attachment features are mating elements selected from a group consisting of a hook and loop attachment system, a magnetic attachment system, or a selective, separable adhesive based attachment system. The Applicant has shown relative to Claim 5 that *Odom* does not disclose the third and fourth attachment features. The Applicant is not claiming a simple hook and loop attachment system rather the Applicant is claiming the specific first and second golf gloves with first and second hook and loop attachment features. Therefore, the Applicant respectfully asserts that the rejection of Claim 8 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claim 9.** Claim 9 is dependent from Claim 3 and contains all the limitations of Claim 3. Claim 8 adds a golf club with a modified golf grip having a fifth attachment feature for selectively coupling to said first location feature to align said first hand inserted in said first golf glove when gripping said modified golf grip. Claim 9 includes both the first and second golf gloves with the first, second, third, and fourth attachment features and the first location feature. Claim 9 further comprises the fifth attachment feature on a modified golf grip. While *Odom*, relative to Fig. 5, does teach an attachment feature for coupling to a cooperative attachment feature on a golf grip 42 on a golf club 40, *Odom* does not disclose all the elements in Claim 9 (including the limitations of Claims 2 and 3 from which it depends. Element

46 of *Odom* offers no help to a golfer in locating his hands on a golf club shaft. Element 46 of *Odom* broadly extends over nearly the entire palm surface of each of his glove 50 and his corresponding “mirror image” golf glove not shown. The cooperating element 42 on golf club 40 extends over the entire periphery of the grip and couples to element 46 but does not aid in locating the golfer’s hand and thus is not a location feature. Therefore, the Applicant respectfully asserts that the rejection of Claim 9 under 35 U.S.C. § 102(b) as being anticipated by *Odom* is traversed by the above arguments.

**Claims 10-22.** Claims 10-22 are directed to a method of teaching a golfer how to attain and maintain a correct golf grip on a golf club comprising the 4 steps. The Examiner states that Claims 10-22 are directed to the obvious method steps of using *Odom*’s device. Office Action, at 3. *Odom* discloses two distinctly different embodiments both of which use a first golf glove and a “mirror image” second golf glove. The two embodiments of *Odom* are directed to golf gloves with different elements. The Examiner fails to point out which of the embodiments of *Odom* the Examiner believes teaches the method steps of Claims 10-22. The Applicant has shown that *Odom* does not disclose the invention of Claim 2 and Claims 3-9 depending therefrom either directly or indirectly. Since the Examiner fails to specifically address the method steps of Claims 10-22, the Examiner fails to make a *prima facie* case of anticipation relative to the reference *Odom*. Therefore, the Applicant respectfully asserts that the rejections of Claims 10-22 under 35 U.S.C. § 102(b) as being anticipated by *Odom* are traversed by the above arguments.

### III. CONCLUSION

Claims 2-22 are pending.

The Applicant has traversed the rejections of Claims 2-22 under 35 U.S.C. § 102(b) as being anticipated by *Odom*.

The Applicant, therefore, respectfully asserts that Claims 2-22 are in condition for allowance and request an early allowance of these claims.

Applicant respectfully request that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Patent Agent and Attorney for Applicant

By: Richard F. Frankeny  
Ross Spencer Garsson  
Reg. No. 38,150  
Richard F. Frankeny  
Reg. No. 47,573

P.O. Box 50784  
Dallas, Texas 75201  
(512) 370-2872

Austin\_1 257709v.1